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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* NICK NYHAN and RONIT AVIV

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Appeal 2009-012680  
Application 09/900,674  
Technology Center 3600

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Decided: June 18, 2010

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Before, MURRIEL E. CRAWFORD, ANTON W. FETTING, and  
JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

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#### STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 1, 3, 5-17, 21-24 and 26-33. Claims 2, 4, 18-20, and 25 are canceled.

We have jurisdiction under 35 U.S.C. § 6(b) (2002). A telephonic Hearing was held on June 8, 2010.

#### SUMMARY OF DECISION

We AFFIRM IN PART (37 C.F.R. § 41.50(b)).

#### THE INVENTION

Appellants claim a system and method for on-line advertising and, more particularly, to soliciting computer users to take on-line surveys. (Specification 1:4-5)

Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A method for conducting an on-line survey in association with presentation of an on-line advertisement by a browser client, the method comprising:

receiving, by a user computer hosting the browser client, a web page configured to display an on-line advertisement;

issuing, by the user computer in association with processing the

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received web page, a request to an ad server, for a block of data comprising computer-readable instructions for presenting the on-line advertisement via the browser client;

providing, by the ad server in response to the issued request from the user computer, the block of data including computer-readable instructions for presenting the on-line advertisement and the block of data further including additional computer-readable instructions that facilitate decision-making steps for determining whether to present an on-line survey solicitation via the browser client;

accessing, on the user computer, a timestamp value indicative of a period of time that has passed since the on-line survey solicitation was previously presented by the browser client; and

executing the additional computer-readable instructions if the timestamp value indicates passage of a period of time satisfying a prescribed wait period between consecutive presentations of the on-line survey solicitation by the browser client on the user computer.

## THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Smith	US 2002/0128898 A1	Sep. 12, 2002
de Ment	US 6,728,755 B1	April 27, 2004
Winn	US 6,901,424 B1	May 31, 2005

The following rejections are before us for review.

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1. The Examiner rejected claims 1, 3, 5-7, 11-17, 26-27, and 33 under 35 U.S.C. §103(a) over Smith in view of de Ment.
2. The Examiner rejected claims 8-10, 21-24, and 28-32 under 35 U.S.C. §103(a) over Smith in view of de Ment and Winn.

## ISSUES

Have Appellants shown that the Examiner erred in rejecting claims 1, 3, 5-7, 11-17, 26-27, and 33 on appeal as being unpatentable under 35 U.S.C. § 103(a) over Smith in view of de Ment on the grounds that: 1) a person with ordinary skill in the art would understand that de Ment discloses presenting a solicitation rather than an outright survey when the user is provided with the opportunity to take the survey and has the option to decline causing the routine to skip to the end; and 2) whether the combination of Smith in view of de Ment and Winn discloses a frequency parameter having a value that is at least partially a function of an amount of time remaining in the campaign, such that the frequency parameter is calculated according to an algorithm that incorporates the amount of time remaining in the campaign?

## PRINCIPLES OF LAW

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406

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(2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). See also *KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

## FINDINGS OF FACT

We find the following facts by a preponderance of the evidence:

1. Smith discloses:

[w]hen a network user completes a survey, cookie information is stored on the computer that identifies the computer as one that has previously been used to participate in the particular survey. Thereafter, when a network user attempts to participate in a particular survey using the same computer, the network user is denied access to the survey. In an alternative embodiment, the automatic survey mechanism maintains previously entered participant information that can be used to identify network users who have previously completed a particular survey.

(¶ [00129]).

2. Smith discloses disabling the survey when the duration for fielding the survey expires. (¶ [0130]).

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3. Smith discloses an online advertisement, e.g., banner, containing a hyperlink to a survey with questions corresponding to a particular banner. (¶ [0124]).

4. de Ment discloses a network connected pop-up servlet for providing pop-up surveys. (Col. 2, ll. 10-23).

5. de Ment discloses a pop-up survey routine which “...begin[s] in response to a user invoking a web tool, which is shown at step 205. This could correspond to any action, as desired by a designer, undertaken by a web user while using the web tool.” (Col. 3, ll. 10-14).

6. de Ment discloses:

[T]he routine determines whether or not the user has seen the particular survey within the last six months. This involves initially checking to see whether the user has a cookie corresponding to the pop-up survey routine. If no such cookie exists, then the routine assumes that the user has not been presented with the survey in the last six months. On the other hand, if such a cookie is stored within the user's system, the routine checks its contents to specifically determine when the user, if at all, was last presented with a pop-up survey. Either way, if it is determined that the user has been presented with the survey in the last six months, then again, the routine returns a value at step 210 indicating that the survey is not to be popped. Conversely, if it is determined that the user has not received the survey in the last six months, then the routine proceeds to decision step 218.

(Col. 4, ll. 42-62).

7. de Ment discloses that:

The purpose of a pop-check routine is to determine whether or not the specific user should be presented with the option to take the pop-up survey. If the pop-check routine 210 returns a value indicating that the user should not be given an opportunity to take the survey, then the routine skips to its end, and the user proceeds with the web tool. On the other hand, if the pop-check routine 210 returns a value indicating that the user should be given the opportunity to take the survey, then the routine proceeds to step 220. At step 220, the user is provided with the opportunity to take the survey. At step 230, if the user declines, opting not to take the survey, the routine skips to the end, and the user proceeds with the web tool. Conversely, if the user accepts and decides to take the survey, the routine proceeds to step 240.

(Col. 3, ll. 28-41).

8. The Examiner found that:

Winn specifically discloses random number generation in the context of frequency selections, as well as cookie data indicating whether or not the user has been previously solicited. It would have been obvious to one of ordinary skill in the art at the time of the invention to include random number generation in the frequency parameters of Smith, Jr. et al. in order to more efficiently gather information from users of the system by defining the goals and objectives of the data to be collected.

(Answer 14).

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9. Examiner took Official Notice that:

[A] URL includes numbers that indicate file locations to which the URL will link. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include random number generation in the frequency parameters of Smith, Jr. et al. in order to more efficiently gather information from users of the system by defining the goals and objectives of the data to be collected.

(Answer 16).

## ANALYSIS

We affirm the rejections of claims 1-3, 5-7, 9-17, 21, 23, 24 and 26-33; and reverse as to claims 8 and 22. While we affirm the rejections of claims 1-3, 5-7, 9-17, 21, 23, 24 and 26-33, we nevertheless designate our Decision as a new ground under 37 C.F.R. § 41.50(b) because our rationale is different from that used by the Examiner.

Initially, we note that the Appellants argue claims 1, 3, 5, 12, 13, 14, 16, 26, 27, and 33 together as a group. Correspondingly, we select representative claim 1 to decide the appeal of these claims, remaining claims 3, 5, 12, 13, 14, 16, 26, 27, and 33 standing or falling with claim 1.

Appellants argue that:

Smith does not disclose a user computer issuing a request to an ad server in association with processing a previously received web page. Instead, Smith, at paragraphs 54- 55, 58, 118, 122-125, and 145-146 (cited in the Final Office action) discloses banner ads delivered within the initially

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downloaded web page.  
(Appeal Br. 9).

We are not persuaded by Appellants' argument here because de Ment discloses a pop-up survey routine which begins in response to a user invoking a web tool, which response, according to de Ment, could correspond to any action desired by a designer (FF 5). We therefore find that the disclosed "any action" commenced on the part of the user in de Ment, constitutes issuing a request as required by the claims.

Appellants next argue that in Smith "[t]he banner ad containing the survey solicitation is downloaded without regard to any previous exposure by the current user to previous solicitations to take a survey." (Appeal Br. 10). We are not persuaded by Appellants' argument because de Ment discloses a routine which checks for a cookie corresponding to the pop-up survey routine to specifically determine *when the user, if at all, was last presented* with a pop-up survey (FF 6).

Appellants argue that in Smith the recited 'accessing' step involves "...reading a cookie to determine whether a user has taken a survey..." and thus the "*timestamp*, disclosed in de Ment, would not be considered useful in Smith's on-line survey presentation method because merely noting the survey was taken is sufficient to prevent users from taking a survey multiple times." (Appeal Br. 10-11). We disagree with Appellants because according to de Ment a timestamp can be used to ascertain whether a survey was taken (FF 6). This taken along with Smith disclosing using cookie information stored on the computer to identify if a computer has previously been used to

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participate in the particular survey (FF 1) would lead a person with ordinary skill in the art to use the time stamp as an indicator that the survey was taken.

Appellants' argument that the combination of Smith and de Ment fails to disclose *executing the additional computer-readable instructions if the timestamp value indicates passage of a period of time satisfying a prescribed wait period between consecutive presentations of the on-line survey solicitation*, is likewise unpersuasive. This is because we find that de Ment explicitly discloses checking to see whether the user has been presented with the survey in the last six months, and if it is determined that the user has not received the survey in the last six months, then the routine proceeds to decision step 218 where the user is given the option of participating in one (FF 6). Appellants' argument that de Ment fails to disclose downloading the data block is likewise unpersuasive because claim 1 only recites *providing* by the ad server which is a far broader term than *downloading* as argued, given that each component of a network provides an interrelated function to the other. Notwithstanding, we find that de Ment nevertheless discloses a pop-up servlet for providing pop up surveys (FF 4)

#### Claims 6, 7 and 15

Appellants' argument that the combination of Smith and de Ment fails to address preventing repeated solicitations fails because de Ment discloses: 1) at step 220, the user is provided with the opportunity to take the survey and at step 230, has the option to decline causing the routine to skip to the end (FF 7) (de Ment thus presents a solicitation rather than an outright

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survey ); and 2) de Ment discloses that the purpose of the pop-check routine is to determine whether or not the specific user should be presented with the option to take the pop-up survey (FF 7).

Claim 11 recites in pertinent part *in response to activation of a link within the pop-up window, sending a web page to the browser client comprising questions regarding a product or service advertised in the on-line advertisement.* Smith discloses an online advertisement, e.g., banner containing a hyperlink to a survey with questions corresponding to a particular banner (FF 3). We therefore find, contrary to Appellants' assertions, that since the survey page corresponds to the involved banner, Smith meets the limitation.

Appellants' arguments against claim 17 have been addressed *supra* with respect to the alleged deficiencies of claim 1 and, for the same reasons given above, Appellants' arguments here are deemed unpersuasive.

#### Claims 8-10, 21-24 and 28-31

Appellants argue with respect to this group of claims that the Examiner has not identified "...Appellants claimed element of changing a frequency parameter in accordance with an amount of time remaining in a campaign." (Appeal Br. 13)

First, claims 21, 23 and 24 and 28-31 do not recite changing a frequency parameter in accordance with an amount of time remaining in a campaign, and thus Appellants' argument to these claims "fail from the outset because . . . they are not based on limitations appearing in the claims . . .," and are not commensurate with the broader scope of the claims. *In re*

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*Self*, 671 F.2d 1344, 1348 (CCPA 1982).

However, with respect to claims 8 and 23, we find that neither Smith or de Ment discloses or infers the changing a frequency parameter in accordance with an amount of time remaining in a campaign feature, and thus we will not sustain the rejection of claims 8 and 23.

### Claim 32

The Examiner relied on Official Notice to find the feature of claim 32 obvious. Claim 32 was filed as a new claim as part of a Response dated June 8, 2007, against which the Examiner issued a Final rejection dated August 24, 2007 using the Official Notice. Appellants only now seek a challenge to the Notice taken by the Examiner (Appeal Br. 14). This challenge fails because it is neither timely or properly presented.

That is, the Examiner made findings that: 1) Winn specifically discloses random number generation in the context of frequency selections (FF 8,9); 2) a URL includes numbers that indicate file locations to which the URL will link ;and 3) therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include random number generation in the frequency parameters of Smith, Jr. et al. in order to more efficiently gather information from users of the system by defining the goals and objectives of the data to be collected (FF 9).

Against these findings, Appellants have not specifically pointed out the supposed errors in the Examiner's taking of Official Notice, "includ[ing] stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR § 1.111(b)." MPEP § 2144.03(C). An

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adequate traverse must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying Examiner's notice of what is well known to one of ordinary skill in the art. *In re Boon*, 439 F.2d 724, 728 (CCPA 1971). That has not been done here. Moreover, Appellants did not make the traverse until the time of Appeal, after the seasonable time when Appellants could have made the challenge in an After Final paper. When an Appellant does not seasonably traverse a well-known statement during examination, the object of the well-known statement is taken to be admitted prior art. *In re Chevenard*, 139 F.2d 711 (CCPA 1943). Accordingly, we sustain the rejection of claim 32.

#### CONCLUSIONS OF LAW

We conclude the Appellants have not shown that the Examiner erred in rejecting claims 1-3, 5-7, 9-17, 21, 23, 24 and 26-33: and have shown that the Examiner erred in rejecting claims 8 and 22.

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This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner . . . .
- (2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record . . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

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## DECISION

The decision of the Examiner to reject claims 1-3, 5-7, 9-17, 21, 23, 24 and 26-33 is AFFIRMED.

The decision of the Examiner to reject claims 8 and 22 is REVERSED.

AFFIRMED IN PART; 37 C.F.R. § 41.50(b)

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